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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,335	12/30/2003	Suzanne Walker Kahne	4555-121 US	8137
7590 Patrick H. Higgins Mathews, Collins, Shepherd & McKay Suite 306 100 Thanet Circle Princeton, NJ 08540			EXAMINER MARTIN, PAUL C	
			ART UNIT 1657	PAPER NUMBER
			MAIL DATE 07/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/748,335

Applicant(s)

KAHNE ET AL.

Examiner

Paul C. Martin

Art Unit

1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-6,8-11 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-6,8-11 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 2, 4-6, 8-11 and 21-23 are pending in this application and were examined on their merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The objections to Claim 8 for minor informalities and to Claim 11 for being dependent upon a rejected base claim have been withdrawn due to the Applicant's amendment to the Claims filed 4/19/07.

The rejection of pending Claims 2 and 4-6 under 35 U.S.C § 102(b) as being anticipated by Kahne *et al.* (US 2002/018266 A1) has been withdrawn due to the Applicant's amendment to the Claims filed 4/19/07.

The rejection of pending Claims 2, 4-6 and 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Kahne *et al.* (US 2002/018266 A1) in view of MacLeod *et al.* (US 6,221,600 B1) has been withdrawn due to the Applicant's amendment to the Claims filed 4/19/07.

Claim Objections

Claim 11 is newly objected to because of the following informalities: The word glycosyltransferase appears to be misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 4-6, 8-10 and 21-23 are newly rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 21 refers to performing a donor displacement assay on a target compound. It is not immediately clear what constitutes a "target" compound, or what method steps are performed in the donor displacement assay or what components are required therein. Claim 21 also refers to a glycosyl donor which can be modified to incorporate a label, it is not clear if the glycosyl donor is modified to incorporate a label or not and therefore the metes and bounds of the claim cannot be determined.

Claim 21 recites the limitation "the glycosyl donor" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claims 4 and 5 recite the limitation "the substrate" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 is newly rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 refers to "measuring the amount of labeled substrate bound to the glycosyltransferase" in line 6 of the claim, then in line 7 refers to "comparing the amount to a standardized amount..." It is unclear whether the amount(s) in line 7 refer to the amount measured in line 6, i.e., whether both are the amount of labeled substrate bound to glycosyltransferase.

Claims 2, 4-6, 8-10, 22 and 23 are rejected as being dependent upon rejected Claim 21.

It is noted that the Examiner called the Attorney of Record, Christopher Casieri on 07/02/07 in order to submit an Examiner's amendment with proposed changes which would overcome the rejections set forth above in order to expedite allowance of the claims, however, the Attorney of Record indicated that the Applicants decided not to approve the changes proposed by the Examiner.

Claim 2, 4-6, 8-10 and 21-23 are free of the art, No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul C. Martin whose telephone number is 571-272-3348. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1657

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Martin
Examiner
Art Unit 1657

7/17/07

/Patricia Leith/

Patricia Leith

Primary Examiner

Art Unit 1655